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POWER DEL VALLE LLP  
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In re Application of:

CARLUCCI, CHRISTINE et al

Serial No.: 09/930,398

Filed: Aug. 15, 2001

Docket: 262.802

Title: MEDICAL TUBING SECURING  
APPARATUS

DECISION ON PETITION TO  
WITHDRAW HOLDING OF  
FINALITY

This is a decision on the petition filed on Sep. 11, 2006 to withdraw the finality of the Office action of Jul. 11, 2006. The petition is being considered pursuant to 37 CFR 1.181 and no fee is required for the petition.

The petition is **DISMISSED**.

In the petition, the applicant requested withdrawal of the finality of the Office action dated Sep. 11, 2006 because the new ground of rejection in the final rejection was neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed pursuant to 37 CFR 1.97(c).

The record shows that:

1. In response to the non-final Office action dated Oct. 29, 2002, on Feb. 5, 2003, the applicant filed an amendment to the claims.
2. On Apr. 9, 2003 the examiner issued a final Office action rejecting all of the claims.
3. On Sep. 11, 2003, the applicant filed an appeal brief.
4. On Nov. 28, 2003, the examiner re-opened prosecution of the applicant and issued a non-final Office action with new grounds of rejection based on new prior art references.
5. On Feb. 27, 2004, the applicant filed a request for reconsideration with no amendments to the claims.
6. On May 18, 2004, the examiner issued a final Office action rejecting all of the claims.
7. On Oct. 21, 2004, the applicant filed an appeal brief.
8. On Jan. 11, 2005, the examiner re-opened prosecution of the application and issued a non-final Office action.
9. On May 16, 2005, the applicant filed an amendment to the claims.
10. On Aug. 19, 2005, the examiner issued a final Office action rejecting all of the claims.

11. On Nov. 7, 2005, the applicant filed an RCE with amendments to all of the independent claims 1, 6 and 11.
12. On Jan. 20, 2006, the examiner issued a non-final Office action rejecting all of the claims.
13. On Apr. 12, 2006, the applicant filed an amendment to all of the independent claims 1, 6 and 11.
14. On Jul. 11, 2006, the examiner rejected all of the claims with new grounds of rejection.
15. On Aug. 9, 2006, the applicant filed an after final response. In the response, the applicant requested that the finality of the final Office action mailed Jul. 11, 2006 be withdrawn.
16. On Sep. 11, 2006, the applicant filed the current request for withdrawal of finality of Office action and issuance of a new Office Action.
17. On Dec. 11, 2006, the applicant filed a pre-appeal brief conference request.
18. On Jan. 19, 2007, the examiner issued an advisory action responding to the after final response dated Aug. 9, 2006 and stated his position why the office action dated Jul. 11, 2006 was made final and would not be withdrawn.
19. On Feb. 12, 2007, the applicant filed an appeal brief.
20. On Mar. 8, 2007, the examiner issued a pre-appeal brief conference decision letter.

#### Discussion and Analysis

Relevant portions of MPEP 706.07(a): Final Rejection, When Proper on Second Action, states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

In order to determine whether or not the amendment filed Apr. 12, 2006 necessitated the new grounds of rejection in the final Office action of Jul. 11, 2006, a comparison of the amended claims filed on Apr. 12, 2006 and the claims filed on Nov. 7, 2005 must be made. A review of the amended claims presented on Apr. 12, 2006 shows that the independent claims 1, 6 and 11 were narrowed in scope by adding the new limitation "such that the band is composed of no more than two layers of fabric anywhere along the length". Based on the newly presented claims, the examiner is now required to consider limitations directed to a band having no more than two

layers of fabric anywhere along the length. The addition of "such that the band is composed of no more than two layers of fabric anywhere along the length" necessitated the new grounds of rejection by requiring US patent 5,117,510 to Broussard et al. to be applied under 35 USC 102 in the final Office action of Jul. 11, 2006. Petitioner's argument in the petition that the applicant's amendment on Apr. 12, 2006 are to substantially the same subject matter as what had been originally filed in Aug. 2001 is not convincing because the applicant has amended the claims numerous times since the original claims were filed on Aug. 2001. In addition, petitioner's request for the examiner to consider applicant's comments in the response filed Aug. 11, 2006 has already occurred with the advisory action issued by the examiner on Jan. 19, 2007. The review of the record shows that the examiner was in compliance with applicable examining practice as set forth in MPEP 706.07(a). Therefore, the amendment to the claims presented on Apr. 12, 2006 necessitated the new grounds of rejection presented in the final Office action issued on Jul. 11, 2006. The examiner's finality of the Office action is correct.

### Conclusion

For the foregoing reasons, the relief requested by petitioners will not be granted. Specifically, the examiner's finality of the Office action dated Jul. 11, 2006 is proper.

The application is being forwarded to Examiner Erez of Art Unit 3731 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is dismissed.

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Frederick R. Schmidt, Director  
Technology Center 3700